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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,055	08/28/2003	Rahul Mital	8317-18	8992

7590

09/08/2005

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EXAMINER

TRAN, DIEM T

ART UNIT

PAPER NUMBER

3748

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/651,055

Applicant(s)

MITAL ET AL.

Examiner

Diem Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-11, 13-19 and 21-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 and 13-18 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-10, 19 and 21-38 is/are rejected.
- 7) ☒ Claim(s) 39-42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

This Office action is in response to the amendment filed on 6/24/05. In this amendment, claims 11, 16, 19 have been amended; claims 3, 4, 12, 20 have been canceled and claims 32-42 have been added. Overall, claims 1, 2, 5-11, 13-19, 21-42 are pending in this application. Upon further search and consideration, the examiner has withdrawn the indicated patentable subject matter of claims 1, 2, 5-10, 26-31; therefore, a new non-final rejection is set forth below.

#### ***Double Patenting***

Claims 1, 2, and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, and 10, respectively, of U.S. Patent No. 6,735,940. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the instant application are broader than the claims in the above patent in that the claims 1, 2 in the instant application lack a second adsorber in the bypass pathway and claim 32 in the instant application lacks a second filter and a second adsorber in the bypass pathway.

Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,820,414. Although the conflicting claim is not identical, they are not patentably distinct from each other because claim 19 in the instant application is broader than the claim in the above patent in that the claim 19 in the instant application lacks a second adsorber in the bypass pathway.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirota et al. (US Patent 6,502,391) in view of Eguchi (JP 6-33735).***

Regarding claim 38, Hirota discloses an internal combustion engine aftertreatment system for treating exhaust gases exiting an engine, the system comprising:

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a valve system having a valve input operatively coupled to the engine exhaust; an adsorber (55) having an input operatively coupled to the first valve output and having an adsorber output; a bypass pathway (Figure 8) having a bypass input operatively coupled to the second valve output and having a bypass output; a temperature sensor (66) and lambda sensor (67) having a sensor input operatively coupled to the valve system input (see Figure 8); however, fails to disclose that a catalytic soot filter having a soot filter input coupled to the adsorber output and the bypass output and having a soot filter output. Eguchi teaches that it is conventional in the art, to utilize a catalytic soot filter (13) having a soot filter input coupled to the adsorber output and the bypass output and having a soot filter output (see Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the teaching of Eguchi in the Hirota system, since the use thereof would have reduced the particulate matter in the exhaust gas.

#### *Allowable Subject Matter*

Claims 11, 13-18 are allowed.

Claims 39-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

Applicant's arguments filed on 6/24/05 have been fully considered but they are moot in view of the new ground(s) of rejection.

*Conclusion*

Any inquiry concerning this communication from the examiner should be directed to Examiner Diem Tran whose telephone number is (571) 272-4866. The examiner can normally be reached on Monday -Friday from 8:00 a.m.- 6:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion, can be reached on (571) 272-4859. The fax number for this group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-786-9199 (toll-free).



Diem Tran  
Patent Examiner  
Art unit 3748

DT  
September 2, 2005



THOMAS DENION  
SUPERVISORY PATENT EXAMINER  
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